

Claims 1-14 are pending in this application. The claim rejections are discussed below.

Claims 1, 2, 5, 7-10 and 13 have been rejected as obvious over Suzuki (Japanese Patent Document 60-26537) in view of Moyer (US 3,375,559).

Claims 1-14 have been rejected as obvious over Ames (US 6,253,341) in view of Turner (US 4,628,677).

Suzuki and Ames are directed to the manufacture of absorbent cores from cellulose acetate filament. Neither Suzuki nor Ames mentions anything about "contaminants, such as adhesives from adhesive applicator 64 from fouling the surface of the roller." (Specification, page 14, lines 18-19). Moyer is directed to an apparatus for bulking filament yarn by using "housing containing a plurality of nested tiers of cylindrical members." (Moyer, Abstract, Column 1, Lines 16-17). Turner is directed to a spinning machine (i.e. a machine for turning staple to yarn) that generates fly (broken fibers from the function spinning process) and that uses filtered pressurized air to affect the spinning process. (Turner, Abstract, Column 4, lines 1-15).

In summary, the rejection, Suzuki in view of Moyer and Ames in view of Turner, state that independent claims 1 and 7 which recite, among other things, "shielding said tow, while de-registering, from contaminants" and "means for shielding said tow, while deregistering, from contaminants" respectfully, are obvious because the references are easily combined. Applicant respectfully disagrees because none of the references, alone or in combination, teach or suggest the problem solved by the instant invention.

The MPEP, § 2143, states that:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations.

Regarding the first criteria, the Court for the Federal Circuit stated that "there are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffett*, 149 F.3d 1350 (Fed. Cir. 1998). Therefore, in order to combine reference

teachings, either the nature of the problem to be solved, the teachings of the prior art, or the knowledge of persons of ordinary skill in the art must motivate or suggest the combination of the references. These three criteria, applied to the instant invention, are discussed below:

1. The nature of the problem to be solved is the first criterion to suggest or motivate the combination of references. The discovery and disclosure of the source and remedy of a problem is nonobvious and involves an inventive step. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 US 45 (1923). In the *Eibel* case, the court ruled that an "invention was not the mere use of a high or substantial pitch to remedy a known source of trouble. It was the discovery of the source not before known and the application of the remedy for which Eibel was entitled to be rewarded in his patent." *Id.* at 68. *Eibel* teaches that an invention is nonobvious when the inventor discovers and discloses the source and remedy for a problem. The instant invention is the discovery and disclosure of the source and remedy of a problem. The problem disclosed by Applicant's disclosure is that contaminants foul the rollers while a tow is being deregistered. The remedy disclosed by Applicant's disclosure is "shielding said tow, while deregistering, from contaminants." Therefore,

Applicant's invention is nonobvious because it is a discovery and disclosure of the source and remedy of a problem.

Applicant's invention arises from the discovery that contaminants foul the rollers while deregistering. In evaluating obviousness, the Court has made it very clear that the suggestion or motivation to combine references "must be founded in the prior art, not in the applicant's disclosure." In re Dow Chemical Co., 837 F.2d 469 at 473 (Fed. Cir. 1988). Where is the statement of this problem in the prior art?

The answer to the foregoing question is found in the instant application and not in the references. Suzuki, Ames and Moyer make no mention of contaminants, much less contaminants in the making of an absorbent composite from a continuous tow. More specifically, the references make no mention of contaminants fouling the rollers while deregistering. Turner, on the other hand, is directed toward a spinning process which involves staple being spun together to form a yarn and does not involve a continuous tow. Therefore, there is no suggestion or motivation in the prior art of the Applicant's problem or their invention.

2. The teaching of the prior art is the second criterion that may suggest or motivate the combination of references. The Court has stated that although a prior art device may be capable of being modified to run the way the apparatus is claimed, "there must be a suggestion or motivation in the reference to do so." *In re Mills*, 916 F.2d 680 at 682 (Fed. Cir. 1990). When applied to the instant invention, Mills directs that, even though references might be, with hindsight, combined for "shielding said tow, while deregistering, from contaminants", there must be a suggestion or motivation within the prior art in order to combine them. Where in the prior art, Suzuki in view of Moyer or Ames in view of Turner, is there a suggestion or motivation that the references should be combined to "shield said tow, while deregistering, from contaminants"? As discussed above, nowhere, only in the instant application. Applicant requests Examiner to come forward with specific language in the prior art, if any exists.

3. The knowledge of persons of ordinary skill in the art is the third criterion that may suggest or motivate the combination of references. The only knowledge of persons of ordinary skill in the art disclosed by the Examiner is in the prior art, Suzuki, Moyer, Ames and Turner. Therefore, where in

the prior art, Suzuki, Moyer, Ames or Turner, is there a suggestion or motivation that a person of ordinary skill in the art would combine the references to "shield a tow, while deregistering, from contaminants"? Again, as mentioned above, nowhere, only in the instant application. Applicant requests Examiner to come forward with specific language in the prior art, if any exists.

In view of the above, the Examiner's conclusion that the claimed invention that includes, among other things, "shielding said tow, while deregistering from contaminants" is obvious is incorrect. None of the three criteria listed in the MPEP, the nature of the problem to be solved, the teachings of the prior art, nor the knowledge of persons of ordinary skill in the art, suggest or motivate the combination of the prior art. The instant invention is the discovery and disclosure of the source and remedy of the problem of contaminants affecting a continuous tow while deregistering. Thus, "shielding said tow, while deregistering, from contaminants" and a "means for shielding said tow, while deregistering, from contaminants" are not lacking inventive step nor obvious.

Therefore, the two obviousness rejections cannot stand.

In view of the foregoing, Applicant requests an early Notice of Allowance.

Respectfully submitted,



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